

REMARKS

This is in response to the non-final Office Action mailed March 4, 2009 wherein the Examiner enters new grounds of rejection. For at least the reasons stated below, Applicants submit that all pending claims are in condition for allowance.

Without prejudice or disclaimer, Applicants cancel claims 21 and 22, moving the elements therein to claim 1. Claim 1 now recites an amendment including “one or more advertisements according to address data associated with the client” and “the AMS being further operative to request one or more replacement advertisements for the one or more selected advertisements wherein the one or more selected advertisements have expired.” Claims 43, 45, 49 and 50 recite amendments including “a computerized method” and “electronically” and a “programmable microprocessor.” These amendments do not add any new matter, as such Applicants request entrance and examination.

Claims 1 – 12, 14 – 23 and 49 stand rejected under 35 U.S.C. §112, ¶1 as failing to comply with the enablement requirement. Claims 1 – 12, 14 – 23 and 34 – 45 stand rejected under 35 U.S.C. §112, ¶2 as being indefinite for failing to particularly point out and distinctly claim the subject matter. In view of the above amendments, Applicants submit these rejections are moot. The Examiner asserts the written description rejections based on the claimed “targeting algorithm,” which has been removed and replaced with the “address data associated with the client.” The Examiner also asserts the rejection based on the claimed “zone,” which as amended, the claims provide further recitation obviating the present rejection. Therefore, Applicants respectfully request withdrawal of the Examiner’s rejections under §112.

Claims 43, 45, 49 and 50 are rejected under 35 U.S.C. 101 as being directed to non-statutory matter. Applicants submit the above the amendments to claims 43, 45, 49 and 50

fully address the Examiner's concerns and satisfy the machine-or-transformation test as recited by the Court in the *In re Bilski* decision. More specifically, the amendments to claims 43, 45, 49 and 50 include a "computerized" method where the method steps are performed "electronically" and by using "a programmable microprocessor." Therefore, Applicants respectfully request withdrawal of the rejections under §101.

Claims 1 – 12, 14, 15, 17 – 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,169,542 to Hooks, et al. ("Hooks") in view of US Patent Publication No. 2002/0123928 to Eldering, et al. ("Eldering"). As mentioned above, claim 1 recites the AMS being further operative to request one or more replacement advertisements for the one or more selected advertisements wherein the one or more selected advertisements have expired. Applicants submit that Hooks and Eldering, either alone or in combination, fail to teach or suggest each and every element as claimed by Applicants, including the request and replacement of expired advertisements.

In support of the rejections for claim 21, now cancelled and incorporated into claim 1, the Examiner asserts that Hooks further discloses the AMS determines whether the user is requesting a program with expired local advertising. Applicants submit that a thorough review of the cited passage as well as the complete disclosure of Hooks does not provide the support asserted by the Examiner. Indeed, Hooks makes no mention of how the system would be operable to determine if an advertisement expired nor does Hooks make any suggestion of one or more replacement advertisements wherein the one or more selected advertisements have expired. Instead, Hooks focuses on menu database of a head end facility which includes menus associated with interactive video subscriber units. The head end facility of the Hooks system maintains and updates each of the menus where entries to the menu database are added and removed in

response to requests from any of various interactive video subscriber units. (Hooks, Col. 9:39 – 52) Hooks does not even discuss the expiration of these menu entries, let alone teach or suggest the replacement advertisements for expired advertisements as claimed by Applicants.

With respect previously-pending claim 21, Applicants note that the Examiner does not assert Eldering cures the deficiencies of Hooks. In rejecting claim 22, however, the Examiner relies on Eldering as teaching the Secure Correlation Server (“SCS”) creates presentation streams that have the same programming but targeted ads in place of the default ad. (Eldering, ¶[0086]) As understood, the SCS receives subscriber profiles from the Secure Profiling Server (“SPS”). According to Eldering, the SCS is configured to correlate ads with subscribers, so that ad effectiveness is increased. The SCS determines which ads (additional national ads or local ads) should be substituted (targeted) for the ad (default ad) within the program stream and which subscribers should receive which ads based on the correlation of ads with subscriber profiles. Like Hooks, Eldering fails to teach or suggest one or replacement ads wherein the one or more selected ads are expired. Eldering substitutes a set of local and national advertisements with another set of local and national advertisements that “correlate” more effectively with a subscriber profile. As such, Eldering fails to teach or suggest Applicants replacement ads as claimed. For at least the reasons mentioned above, Applicants submit the rejections under §103(a) are no longer tenable and respectfully request withdrawal.

Claim 24 – 31, 45 – 50, 52 and 53 stand rejected under 35 U.S.C. 102(b) as being anticipated by Eldering. Independent claim 24 recites an amendment including “determining whether the geographically zoned local advertisement has expired and replacing an expired geographically zoned local advertisement with a replacement advertisement.” Similarly, independent claims 45, 49 and 50 recite amendments including associating one or more local

advertisements with the given program wherein the one or more local advertisements include a zone identifier proximate to the geographical zone and determining whether the geographically zoned local advertisement has expired and replacing an expired geographically zoned local advertisement with a replacement advertisement.

As understood, Eldering is directed at a system, method and apparatus for targeting advertisements (ads) to subscribers. The Eldering system targets ads to subscribers by correlating subscriber profiles with ad profiles. The subscriber profiles identify characteristics and/or traits associated with the subscriber and the ad profiles identify characteristics and/or traits about an intended target market for the ad. Eldering fails to disclose determining whether the geographically zoned local advertisement has expired and replacing an expired geographically zoned local advertisement with a replacement advertisement. Indeed, Eldering fails to disclose a system or method that even suggests advertisements that may expire and replacing the expired advertisements with one or more replacement advertisements. As such, Applicants respectfully submit that Eldering fails to identically disclose each and every element as claimed. Therefore, Applicants respectfully request withdrawal of the rejections for the claims the Examiner asserts are anticipated by Eldering.

Claim 34 – 40 and 42 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,588,013 to Lumley (“Lumley”). Without prejudice or disclaimer, Applicants cancel claim 42 moving the elements therein to independent claim 34 which now recites “one or more geographically” zoned local advertisements and the requested program; and “the AMS being further operative to request one or more replacement advertisements for the one or more geographically zoned advertisements wherein the one or more selected advertisements

have expired.” In light of these amendments, Applicants submit Lumley fails to identically disclose each and every element as claimed.

As understood, Lumley is directed to a promotional video system in which promotional events are logged in a promotional event log that is used to automatically update a promotional material selection algorithm. Lumley discusses a main facility for providing program guide data and promotional material to television distribution facility. According to Lumley, environmental situations, e.g., the weather, are detected and detectable environmental situation information is provided to a promotional material selection unit where the promotional material selection unit may select promotional material for distribution according to a promotional material selection algorithm that may be defined using a script. Lumley’s promotional material selection algorithm script allegedly uses selection parameters such as promotional material attribute and detectable environmental situation parameters.

In contrast, none of the promotional material attributes or detectable environment situation parameters discussed by Lumley include any mention of the expiration of local advertisements. The AMS, as claimed by Applicants is operative to request one or more replacement advertisements for the one or more geographically zoned advertisements wherein the one or more selected advertisements have expired. As such, Applicants respectfully submit that Lumley fails to identically disclose each and every element as claimed. Therefore, Applicants respectfully request withdrawal of the rejections for the claims the Examiner asserts are anticipated by Lumley.

The dependent claims of the present application contain additional features that further substantially distinguish the invention of the present application over the prior art of

record. Given the Applicants' position on the patentability of the independent claims, however, it is not deemed necessary at this point to delineate such distinctions.

For at least all of the above reasons, Applicants respectfully request that the Examiner withdraw all rejections, and allowance of all the pending claims is respectfully solicited. To expedite prosecution of this application to allowance, the Examiner is invited to call the Applicants' undersigned representative to discuss any issues relating to this application.

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THIS CORRESPONDENCE IS BEING
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